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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,385	06/19/2001	Tetsuji Ishikawa	109683	1065
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EXAMINER				
GRAY, LINDA LAMEY				
ART UNIT		PAPER NUMBER		
1734				

DATE MAILED: 12/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/883,385

Applicant(s)

ISHIKAWA ET AL.

Examiner

Linda L. Gray

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14, 15 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12, 14-15, and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

**Request for Continued Examination**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 11-14-03 has been entered.

**Claim Rejections - 35 USC § 112**

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Claim 21** is indefinite because "said hole" lacks antecedent basis.

**Claim Rejections - 35 USC § 103**

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. **Claims 12, 14-15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2726856 in view of Cram et al. (US 5,620,544).**

**Claims 12**, JP'856 teaches a process for producing a roll (i.e., ink ribbon roller) including cutting wide main film R along its running direction using slit knife unit 3 while running it in the direction perpendicular to its width, thereby producing a plurality of

narrow main tapes r, followed by winding each tape r to produce a roll. The process includes **(a)** sending adhesive film T from a roll including film T wound, **(b)** arranging film T on a surface of a portion of film R where the portion becomes a winding termination position of tapes r, **(c)** sticking film T on a surface of film R to form film t, **(d)** moving film t and film R together along their running direction, and **(e)** cutting film t together with film R.

*JP'856 does not teach first printing a desired item on a surface of the winding terminal position on film t.)*

Cram et al. teach a tab at the end of a roll of web where the tab is the winding termination position of the roll. Note that the tabs have been printed (printer) with identifying indicia on both sides. Since the tab is printed on both sides such is printed upon before bonding to the termination position in order to obtain the print between the tab and the portion of the tab bonded to the rolled web (Fig 2; c 4, L 6, to c 6, L 61).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in JP'856 first printing a desired item on a surface of film t because Cram et al. teach printing on a winding termination position of a roll of material in order to provide identification information about the roll where such in JP'856 would be used to provide identification information about film R which would be beneficial to those using the ink ribbon roller.

**Claim 15**, JP'856 teaches that film T is sent in a direction perpendicular to the running direction of film R and is then stuck on a surface of film R.

**Claim 14**, *JP'856 does not teach feeding film T along the running direction.*

However, such is well known alternative to perpendicular feeding, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in JP'856 feeding film T along the running direction because it is obvious to replace one direction of feeding with another art recognized alternative feeding direction.

**Claim 20**, the printer would be in the vicinity of film T (upstream side of unit 3) along a running direction of film R.

**6. Claims 12, 14-15, and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US 4,339,294) in view of Cram et al.**

**Claim 12**, Jones teaches a process for producing roll 13 including cutting wide main film 1 along its running direction using slit knife unit 10 while running it in the direction perpendicular to its width, thereby producing a plurality of narrow main tapes 11, followed by winding each tape 11 to produce roll 13. The process includes **(a)** sending an adhesive film from roll 7 including the adhesive film wound, **(b)** arranging the adhesive film on a surface of a portion of film 1 where the portion becomes a winding termination position of tapes 11, **(c)** sticking the adhesive film on a surface of film 1, **(d)** moving the adhesive film and film 1 together along their running direction, and **(e)** cutting the adhesive film together with film 1.

*Jones does not teach first printing a desired item on a surface of the winding terminal position on the adhesive film.*

In view of Cram et al., it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Jones first printing a desired item on a surface of the adhesive film because Cram et al. teach printing on a winding termination position of a roll of material in order to provide identification

information about the roll where such in Jones would be used to provide identification information about film 1 which would be beneficial to those using the material of roll 13 for its intended purpose.

**Claim 15**, Jones teaches that the adhesive film is sent in a direction perpendicular to the running direction of film 1 and is then stuck on a surface of film 1.

**Claim 14**, *Jones does not teach feeding the adhesive film along the running direction.*

However, such is well known alternative to perpendicular feeding, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Jones feeding the adhesive film along the running direction because it is obvious to replace one direction of feeding with another art recognized alternative feeding direction.

**Claim 18**, Jones teaches the adhesive film is arranged on the surface of film 1 on a portion which becomes a winding termination position of film 1 (c 3, L 1-29).

**Claim 19**, Jones teaches forming holes 5a and 5b in film 1 where the adhesive film is over holes 5a and 5b. **Claim 20**, the printer would be in the vicinity of the adhesive film (upstream side of unit 10) along a running direction of film 1. **Claim 21**, the adhesive film exposed in the bottom of holes 5a and 5b is stuck to film 1.

### **Response to Arguments**

**7.** Applicants' comments filed 11-14-03 have been fully considered.

*Applicants assert that neither Kondo nor Cram nor Jones teach or suggest an adhesive film printed on a desired item on a surface of the adhesive film beforehand, as recited in claim 12.*

In response, see the discussion of Cram where it is indicated that tab is printed on both sides such is printed upon before bonding to the termination position in order to obtain the print between the tab and the portion of the tab bonded to the rolled web (Fig 2; c 4, L 6, to c 6, L 61).

**Allowable Subject Matter**

**8.** The following subject matter is found to be allowable but not currently claimed: the prior art does not teach the adhesive film to be of a width approximately equal to the width of the main film but teach that the cutting of the adhesive film provides a cut piece equal to the width of the main film

**Conclusion**

**9.** Any inquiry concerning this communication or earlier communications should be directed to Examiner Linda L. Gray at (703) 308-1093 (after 12-18-03: (571) 272-1228), Monday-Friday from 6:30 am to 3:30 pm. The fax number is (703) 872-9306.

llg

*llg*  
December 9, 2003

*Linda L. Gray*  
LINDA GRAY  
PRIMARY EXAMINER